

Appl. No. 09/728,717  
Amdt. dated August 31, 2005  
Reply to Final Office Action of June 3, 2005

### REMARKS

Claims 1 to 20 were pending in the application at the time of examination. The Examiner objected to the specification and Claim 20. Claims 19 and 20 stand rejected as anticipated. Claims 1 to 18 stand rejected as obvious.

In view of the objections to the specification and Claim 20, Applicant has amended the specification and Claim 20 as suggested by the Examiner. Applicant respectfully submits that the amendments do not require consideration of new issues or a new search. Applicant respectfully requests entry of the amendments under Rule 116.

Claims 1 to 5, 7 to 11, and 13 to 17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,377,354, hereinafter referred to as Nguyen, in view of U.S. Patent No. 5,959,857, hereinafter referred to as Speciner.

Applicant respectfully traverses the obviousness rejection of independent Claims 1, 7, and 13. To make a prima facie obviousness rejection, the MPEP directs:

#### **BASIC CONSIDERATIONS WHICH APPLY TO OBVIOUSNESS REJECTIONS**

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

MPEP § 2141, 8th Ed., Rev. 2, p. 2100-120 (May 2004). It is noted that this directive stated "the following tenets . . . must be adhered to." Accordingly, failure to adhere to any one of these tenets means that a prima facie obviousness rejection has not been made.

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The final rejection failed to adhere to multiple of these tenets. As demonstrated more completely below, the claimed invention has not been considered as a whole; the references have not been considered as a whole; and the rejection mischaracterizes common terms in the art. Pieces of the references have been extracted and selectively interpreted in view of Applicant's claims. Also, the pieces selectively extracted are from different functional levels, e.g., taking an bitmap that is effectively pixel data and applying the bitmap to a completely different level of abstraction, a list. Finally, there was no explanation of how the primary reference would work for its intended purpose following the modification.

In the obviousness rejection of Claim 1, the original rejection was repeated and then as a basis for maintaining the rejection, the Examiner stated in part:

The graphic objects as disclosed by Nguyen et al are grouped by transparency as evident in Figure 4 where the bitmap image 168 does not obscure the text object 174 and 176 thus implying the object 168 is a transparent object.

Applicant respectfully notes that no citation of the word "transparent" or "transparency" has been made to Nguyen, and this general statement is Examiner argument that ignores the explicit teaching of the reference. In fact, the very next statement contradicts the conclusion reached. Specifically, the rejection stated:

Further in Figure 3B, Nguyen et al teaches [Sic] that when text and graphic objects overlap they are drawn as union.

This statement fails to support the rejection and in fact demonstrates that the rejection is not well founded. When the elements overlap as in Fig. 4, Nguyen does not teach determining whether object 168 is a transparent object and

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instead taught that only if there is an overlap, the overlapping objects are redrawn as a single bit map, i.e.,

As these bounding rectangles 174, 176 have an overlap with the bitmap bounding rectangle 168, the potential for merging problems (Z-order problem) described above exists. Therefore, text elements 170 and 172 are drawn as part of the bitmap graphic 166, and not printed as separate text elements. The new bitmap graphic 178 has a bounding rectangle 180 which corresponds to the union of the regions bounded by bounding rectangles 168, 174, and 176.

Nguyen, Col. 8, lines 8 to 16.

Thus, Nguyen taught that it was necessary to perform special operations to combine the text and the bitmap into a new bitmap whenever there was an overlap. The rejection has cited no teaching that the processing was done based on a characteristic of the bitmap, i.e., a transparent graphic object as recited in Claim 1. Nguyen teaches away from the conclusions in the rejection and demonstrates that the reference was not considered as a whole because every bitmap is sequentially processed for overlap and not just bitmaps with a particular characteristic in a list as in Claim 1.

The failure of the rejection to consider the reference as a whole is further demonstrated by the taking of an adverb that described a combination of text and bitmap in a print process and turn it into an adjective describing the characteristics of a bitmap. In considering the reference as a whole, "transparently combined in the print process" must be interpreted in view of the reference as a whole. Nguyen taught:

. . . to ensure correct output when the text and bitmaps are combined during the print process. Preferably, an embodiment of the printer driver of the instant invention accomplishes the above in a single pass fashion as the print commands are received from the graphics device interface (GDI). The elimination of any subsequent passes through the print command or data information, also

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greatly enhances the overall performance of the printing function.

Nguyen, Col. 3, lines 45 to 52.

Advantageously, this regionalizing and characterization is accomplished in a single pass per drawing call as illustrated in FIGS. 3A and 3B

Nguyen, Col. 8, lines 26 to 28.

Thus, Applicant respectfully submits that "transparently combined in the printing process" means that the union of the elements is accomplished in a single pass. Transparently forming a combination in a printing process teaches or suggests nothing about either object in the combination, but rather how the combination is done in the printing process.

The rejection continues and demonstrates still further an improper form of analysis in view of the requirements of the MPEP as quoted above. The rejection makes two inconsistent definitions. First,

Thus, the bitmap buffer acts as a list of transparent objects by storing all the transparent objects and texts which overlap transparent objects.

This is evidence that the level of skill in the art has not been considered, that both the claim language and the reference have been reduced to a gist, and that the sequence in the claim language has been ignored. All of which go against the requirements of the MPEP as quoted above.

First, a bitmap buffer is not a list of anything. A bitmap is well known to be "a set of bits that represents a graphic image, with each bit or group of bits corresponding to a pixel in the image."

[www.yourdictionary.com/ahd/b/b0286150.html](http://www.yourdictionary.com/ahd/b/b0286150.html). Accordingly, a bitmap buffer is a buffer that holds sets of bits that

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represent graphic images, i.e., pixel data. This is not a list and one of skill in the art would not consider it to be so.

Once the data is written to the bitmap buffer, the rejection has failed to cite any teaching that anything is down with the bitmap, and in fact, Nguyen teaches that it can be redrawn and printed. This fails to suggest using data in the bitmap buffer as a list as recited in Claim 1. Thus, the reference as a whole contradicts the conclusions reached in the rejection.

Next, the rejection does not say it is the list in the bitmap buffer that is used, but instead jumps to an entirely different definition, specifically, the rejection stated:

. . . Nguyen stores the location of graphic objects and text objects which overlap graphic objects transparently in memory, there is a listing in memory of all such object which reads on creating a transparency list . . .

Thus, the list of transparent objects is defined as the bitmap buffer in the rejection, but the creation of the transparency list is associated with storing locations. This inconsistency alone is a demonstration that the rejection is not well founded. Further, as noted above, there is no teaching of transparent objects. In addition, Nguyen was electronically searched and the word "list" was not found.

One reason is that Nguyen taught a fundamentally different process, as illustrated in Figs. 3A and 3B. As quoted above, Nguyen taught a sequential one pass process going bitmap by bitmap for every bitmap. In contrast, Claim 1 recites:

creating a transparency list containing the transparent graphics objects of said document page;  
and  
converting only objects contained in said transparency list into bitmaps for printing

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Thus, a transparency list is created and then only objects in this list are converted to bitmaps according to Claim 1. The sequential processing of Nguyen fails to teach or suggest this sequence of operations. Any one of the above noted deficiencies is sufficient to overcome the obviousness rejection.

Next, Applicant respectfully notes that the combination of references was traversed for multiple reasons in the prior response. None of these reasons were addressed or acknowledged in the final action and so Applicant respectfully submits that the record demonstrates that the combination is not well founded and this demonstration has not been refuted. The unrefuted comments concerning the combination of references from the prior response is incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 1, 7 and 13.

Claims 2 to 5 depend from Claim 1 and so distinguish over the combination of reference for at least the same reasons as Claim 1. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 2 to 5.

Claims 8 to 11 depend from Claim 7 and so distinguish over the combination of reference for at least the same reasons as Claim 7. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 8 to 11.

Claims 14 to 17 depend from Claim 13 and so distinguish over the combination of reference for at least the same reasons as Claim 13. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 14 to 17.

Claims 6, 12, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nguyen in view of Speciner

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and further in view of U.S. Patent No. 5,335,316, hereinafter referred to as Toyokura.

Applicant respectfully traverses the obviousness rejection. Assuming the combination of the three references is proper, the information from Toyokura fails to cure the deficiency of the two primary references. In addition, there has been no showing how the sequential process of the primary reference would still perform the one pass process with the proposed modifications, and so the combination is not well founded. Thus, each of Claims 6, 12, and 18 distinguishes over the combination of references for at least the same reasons as the independent claim from which it depends. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claims 6, 12, and 18.

Claims 19 and 20 stand rejected as anticipated by Nguyen. The above comments concerning, transparent objects, lists, and the sequence of operations in Nguyen are incorporated herein by reference. Moreover the rejection failed to cite any teaching of a non-transparent object that included a plurality of text words that overlapped the transparent graphics object, and the entire non-transparent object including the plurality of words was added to a list. Therefore, Claims 19 and 20 distinguish over Nguen. Applicant requests reconsideration and withdrawal of the anticipation rejections of Claims 19 and 20.

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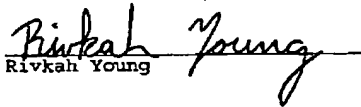
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Claims 1 to 20 remain in the application. Claim 20 is amended. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant.

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. 571-273-8300, on August 31, 2005.

  
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August 31, 2005  
Date of Signature

Respectfully submitted,



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